

## REMARKS/ARGUMENTS

The present amendment is submitted in response to the Office Action received from the United States Patent Office dated December 13, 2007. In the Office Action, the Patent Office rejected Claims 1, 17 and 33 under 35 U.S.C. §101 as non-statutory double patenting over United States Patent Number: 5,721,951. The Patent Office rejected Claims 3-8, 10-12, 19-24, 26-28, 35-40 and 42-44 under 35 U.S.C. §101 as non-statutory obviousness-type double patenting as being unpatentable over claims 3-8, 10-12, 15-20, 22-24, 27-32 and 34-36 of U.S. Patent Number: 5,721,951. The Patent Office rejected Claims 1-12, 17-28, 33-44 and 55-59 under 35 U.S.C. § 102(b) as being anticipated by *DorEl* (U.S. Patent Number 5,721,951). Additionally, the Patent Office rejected Claims 13-16, 32, 45-54 and 60 under 35 U.S.C. § 103(a) as being unpatentable over *DorEl* (U.S. Patent Number 5,721,951) in view of *Ooe* (U.S. Patent Number 5,901,328). Finally, the Patent Office Action cited a double patenting over U.S. Patent Number 5,721,951.

The Patent Office rejected Claims 1-12, 17-28, 33-44 and 55-59 under 35 U.S.C. § 102(b) as being anticipated by *DorEl*. The Patent Office states that *DorEl* discloses a multimedia apparatus configured for use in a home entertainment system, said apparatus comprising (see fig. 1, col. 2, lines 57-60, col. 3, lines 65-67 and col. 4, lines 1-5). A data communication link configured to receive a software program via a network;(see fig. 5 (38), col. 3, lines 16-21 and col. 7, lines 17-27). A processing device configured to identify the software program received by the data communications link and to determine whether said software program needs to be installed or has already been installed, and if it needs to be installed, to determine whether installation information relating to the software program is available to the processing device, said processing device further being configured to begin playing the software program if it has already been installed or to automatically initialize an installation of the software program prior to playing the software program if the installation information is available (fig. 3 and col. 5, lines 27-67, col. 6, lines 1-21); and an output means for providing audio and image data resulting from playing of the software program to the hose system (col. 2, lines 62-67).

*DorEl* discloses a dedicated apparatus for playing unmodified prerecorded software in a home computer system, and more particularly an apparatus, housed in a home entertainment

system chassis, for playing in a home entertainment environment the existing body of interactive multimedia software that has been formatted and published for compatibility with standard personal computer platforms such as the MPC CD-ROM platform. Video and audio output signals are generated in response to the processing of the multimedia software program, which are fed to the home entertainment system for presentation to an audience. A further aspect is the provision of a "drop & play" feature which automatically initiates playing of multimedia software in a sequence that appears to be similar to playing audio CDs, i.e., without requiring any further action from a user after selecting play. This feature is in part provided by a table containing installation information for each of numerous multimedia software titles; entries in this table are preferably indexed by an identifier that can be uniquely derived from a given CD-ROM or other published multimedia media such as a diskette.

Amended Claim 1 requires a multimedia apparatus configured for use in a home entertainment system, said apparatus comprising: a data communications link configured to receive a software program via a network wherein the software programs are formatted and published for compatibility with standard computer platforms; a processing device configured to identify the software program received by the data communications link and to determine whether said software program needs to be installed or has already been installed, and if it needs to be installed, to determine whether installation information relating to the software program is available to the processing device, said processing device further being configured to begin playing the software program if it has already been installed or to automatically initialize an installation of the software program prior to playing the software program if the installation information is available whereby the processing device is capable of initiating the software program without alteration or additional configuration of the software program; and an output means for providing audio and image data resulting from playing of the software program to the home system.

Amended Claim 17 requires a home entertainment system comprising: an input for receiving user commands; a display for presentation of image data; an audio circuit for presentation of audio data; one or more audio or video components for playing audio or video recordings; and a multimedia apparatus having capability of playing software programs, comprising: a data communications link configured to receive a software program via a network wherein the software programs are formatted and published for compatibility with standard

computer platforms; a processing device configured to identify the software program received by the data communications link and to determine whether said software program needs to be installed or has already been installed, and if it needs to be installed, to determine whether installation information relating to the software program is available to the processing device, said processing device further being configured to begin playing the software program if it has already been installed or to automatically initialize an installation of the software program prior to playing the software program if the installation information is available whereby the processing device is capable of initiating the software program without alteration or additional configuration of the software program; and an output means for providing audio and image data resulting from the playing of the software program to the audio means and the display means.

Moreover, Amended Claim 33 requires a method of executing a software program in a home entertainment system, said method comprising: providing a data communications link configured to receive software program from a network whereby the communications link provides access to interactive television services, video conferencing and instant replay of television transmission, interactive multimedia software programs and other multimedia medium; identifying the software program being read by the reading means; determining whether the software program needs to be installed or has already been installed, and should it need to be installed, whether installation information relating to the software program being read by the reading means is available to be used to perform an automatic installation of the software program; beginning the playing of the software program if it has already been installed or automatically initializing an installation of the software program prior to executing the software program if the installation is available; and providing audio and image data resulting from the playing of the software program to the home entertainment system.

*DorEl* does not teach or suggest a data communications link configured to receive a software program via a network wherein the software programs are formatted and published for compatibility with standard computer platforms; and a processing device configured to identify the software program received by the data communications link and to determine whether said software program needs to be installed or has already been installed, and if it needs to be installed, to determine whether installation information relating to the software program is available to the processing device, said processing device further being configured to begin playing the software program if it has already been installed or to automatically initialize an

installation of the software program prior to playing the software program if the installation information is available whereby the processing device is capable of initiating the software program without alteration or additional configuration of the software program as required by Claim 1 and Claim 17. Moreover, *DorEl* does not teach or suggest providing a data communications link configured to receive software program from a network whereby the communications link provides access to interactive television services, video conferencing and instant replay of television transmission, interactive multimedia software programs and other multimedia medium as required by Claim 33.

Under 35 U.S.C. §102(b), anticipation requires that a single reference disclose each and every element of Applicant's claimed invention. *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471, 1479, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986).

Moreover, anticipation is not shown even if the differences between the claims and the reference are "insubstantial" and one skilled in the art could supply the missing elements. *Structure Rubber Products Co. v. Park Rubber Co.*, 749 F.2d. 707, 716, 223 USPQ 1264, 1270 (Fed. Cir. 1984).

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (MPEP § 2131).

In view of the foregoing remarks and amendments, the rejection of Claims 1-12, 17-28, 33-44 and 55-59 under U.S.C. §102(b) as being anticipated over *DorEl* have been overcome. Notice to that effect is requested.

The Patent Office further rejected Claims 13-16, 32, 45-54 and 60 under 35 U.S.C. § 103(a) as being unpatentable over *DorEl* (U.S. Patent Number 5,721,951) in view of *Ooe* (U.S. Patent Number 5,901,328). The Patent Office states that *DorEl* discloses everything claimed as applied to Claims 1 and 17, method for automatically installing a software program from a CD-ROM/DVD, facilitating automatic installation of the software program (col. 3, lines 3-15). However, *DorEl* fails to specifically disclose storing an instruction set in a header information area of the CD-ROM/DVD. *Ooe* discloses storing an instruction set in a header information area of the disk (col. 12, lines 28-41). The Patent Office states that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify *DorEl's* invention with the limitation as taught by *Ooe* for the advantage of improving performance.

*DorEl* discloses a dedicated apparatus for playing unmodified prerecorded software in a home computer system, and more particularly an apparatus, housed in a home entertainment system chassis, for playing in a home entertainment environment the existing body of interactive multimedia software that has been formatted and published for compatibility with standard personal computer platforms such as the MPC CD-ROM platform. Video and audio output signals are generated in response to the processing of the multimedia software program, which are fed to the home entertainment system for presentation to an audience. A further aspect is the provision of a "drop & play" feature which automatically initiates playing of multimedia software in a sequence that appears to be similar to playing audio CDs, i.e., without requiring any further action from a user after selecting play. This feature is in part provided by a table containing installation information for each of numerous multimedia software titles; entries in this table are preferably indexed by an identifier that can be uniquely derived from a given CD-ROM or other published multimedia media such as a diskette.

*Ooe* discloses a memory protection setting unit sets a protection area in a multiport memory provided with two ports, that is, port A and port B. The CPU accesses the multiport memory through port A. At this time, an area other than the protection area can be accessed. The CPU transmits data to an external device through a transfer control device. The transfer control device accesses the multiport memory through port B. Only the protection area can be accessed at this time. Upon receipt of a request from the CPU, the transfer control device writes data received from the external device to the protection area and reads data to be sent to the external device from the protection area. Protection is removed by the memory protection setting unit from the protection area where data is read or written by the transfer control device.

However, as enumerated above, neither *DorEl* nor *Ooe*, taken singly or in combination teach or suggest a data communications link configured to receive a software program via a network wherein the software programs are formatted and published for compatibility with standard computer platforms; and a processing device configured to identify the software program received by the data communications link and to determine whether said software program needs to be installed or has already been installed, and if it needs to be installed, to determine whether installation information relating to the software program is available to the processing device, said processing device further being configured to begin playing the software program if it has already been installed or to automatically initialize an installation of the

software program prior to playing the software program if the installation information is available whereby the processing device is capable of initiating the software program without alteration or additional configuration of the software program as required by Claim 1 and Claim 17. Moreover, neither *DorEl*, nor *Ooe* teach or suggest providing a data communications link configured to receive software program from a network whereby the communications link provides access to interactive television services, video conferencing and instant replay of television transmission, interactive multimedia software programs and other multimedia medium as required by Claim 33.

It is further submitted that the question under §103 is whether the totality of the art would collectively suggest the claimed invention to one of ordinary skill in this art. In re Simon, 461 F.2d 1387, 174 USPQ 114 (CCPA 1972).

That elements, even distinguishing elements, are disclosed in the art is alone insufficient. It is common to find elements somewhere in the art. Moreover, most if not all elements perform their ordained and expected functions. The test is whether the invention as a whole, in light of the teaching of the reference, would have been obvious to one of ordinary skill in the art at the time the invention was made. Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983).

It is insufficient that the art disclosed component's of Applicants' invention. A teaching, suggestion, or incentive must exit to make the combination made by Applicants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1988).

In view of the foregoing remarks and amendments, the rejection of Claims 13-16, 32, 45-54 and 60 under 35 U.S.C. § 103(a) as being unpatentable over *DorEl* in view of *Ooe* have been overcome. Notice to that effect is requested.

Claims 2-16 depend from Claim 1; Claims 18-32 depend from Claim 17; Claims 34-44 depend from Claim 33; Claims 46-48 depend from Claim 45; Claims 50-54 depend from Claim 49; and Claims 57-58 depend from Claim 56. These claims are further believed to be allowable for the same reasons set forth with respect to independent Claims 1, 17, 33, 45, 49 and 56 since each sets forth an additional novel elements and steps of Applicant's Home Entertainment System and Method.

Enclosed is a Terminal Disclaimer to Obviate a Double Patenting Rejection Over a "Prior" Patent on *DorEl* (U.S. Patent Number 5,721,951). The Commissioner is hereby

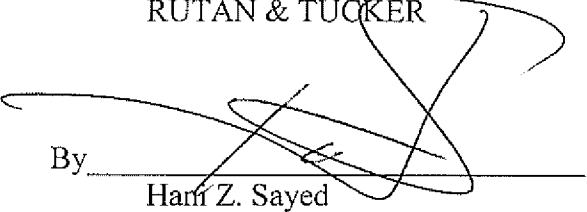
authorized to deduct filing fees in connection with this Terminal Disclaimer and other filing fees from Deposit Account No. 50-2191.

In view of the foregoing remarks, Applicant respectfully submits all of the claims in the application are in allowable form and that the application is now in condition for allowance. If any outstanding issues remain, Applicant urges the Patent Office to telephone Applicant's attorney so that the same may be resolved and the application expedited to issue. Applicant requests the Patent Office to indicate all claims as allowable and to pass the application to issue.

Respectfully submitted,  
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